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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,139	03/06/2002	William D. Tandy	4333.1US (99-0257.1)	9714
24247	7590	08/03/2005	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 08/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,139

Applicant(s)

TANDY ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,8,9,11,12,14,16,17,19,20,22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8,9,11,12,14,16,17,19,20,22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 6/29/2005. Applicants' amendments to the title of the invention, and claims 1, 4, 9 and 17 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicants' amendments to claims 1, 9 and 17 overcome the rejection in section 6 of Office action dated 3/25/2005.

Rejections Based on Prior Art

4. Claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weng et al. (US 5972234) in view of Robertson (US 5855969), generally as set forth in section 8 of Office action dated 3/25/2005, together with the following additional reasoning and response to argument.

First, for the purpose of clarification, the Examiner repeats the relied upon prior art as follows: Weng's invention is directed to a laser mark tape for marking a wafer (semiconductor device). In one embodiment, Weng teaches a marking tape for making an identification mark by a high-intensity energy beam (column 2, lines 20-21), such as a laser (column 1, line 32). Weng also teaches that any suitable tape of polymeric

based material, which can be easily patterned by high-intensity energy beams such as ultraviolet light or laser, can be used (column 4, lines 27-33). The marking tape adheres to a substrate to be marked (column 2, line 64). A release layer, such as a polypropylene or PET film, may be provided to cover the adhesive layer for protection during the laser marking process (column 4, line 64 to column 5, line 2). Additionally, Robertson's invention is directed to a method for marking metal or other product for its identification (Abstract). Robertson teaches that a layer of coating containing an additive that is darkenable under a laser beam is cured to form a product identification indicia (Abstract; column 6, lines 26-32). The identification system can withstand the rigors of primary metal mills (i.e., permanent) (column 2, lines 19-21). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify Weng's laser marking layer with a layer of Robertson's laser curable and darkenable coating, motivated by the desire to obtain a permanent product identification marking. As to the two-layer adhesive structure, since each of the first outermost adhesive layer and the second adhesive layer is merely recited as electromagnetic radiation-curable; and amended Fig. 5 (12/20/2004) also expressly shows that the two layers are of the same material 1B, in the absence of any distinction between the radiation-curable components of the first and second adhesive layers, Weng's single-layer adhesive structure reads on both the first and second adhesive layers of the instant invention. In other words, while the independent claims recite "different" layers, they do not preclude a single layer from achieving all of them, i.e., the properties of one layer are not exclusive of the other. Further, the Examiner notes that Weng's single

layer of curable marking tape layer also inherently reads on the limitation “the second layer ... curing onto ... the first ... adhesive layer”.

With respect to Applicants’ argument “The Robertson reference teaches or suggests the use of a CO₂ laser to darken a coating containing an additive that is darkenable under the action of the laser. Nowhere in the Robertson reference does the word “cure” appear in any description of the additive in the coating” (Remarks, page 8, second full paragraph), the Examiner repeats that Robertson expressly teaches that a layer of coating containing an additive that is darkenable under a laser beam is cured to form a product identification indicia (column 6, lines 26-32), Applicants’ argument to the contrary notwithstanding.

With respect to Applicants’ argument “any combination of the cited prior art fails to teach or suggest the claim limitations of presently amended independent claims 1, 9, and 17 calling for “a first outermost adhesive layer comprising a mixture of electromagnetic radiation-curable components ...” and “a second layer disposed between the tape and the first outermost adhesive layer, the second adhesive layer comprising a mixture of electromagnetic radiation-curable components ...”, Applicants assert that ... Weng et al. reference, at best, teaches or suggests a tape having one single adhesive layer, not a tape having multilayer adhesive” (Remarks, page 9, first full paragraph), and “The second layer of adhesive has different properties from the first layer of adhesive. The different properties of the first layer of adhesive and the second layer of adhesive are clearly distinct from each other as ... described in the independent claims 1, 9, and 17 and in Applicants’ disclosure” (Remarks, page 9, bottom 5 lines), the

Examiner repeats that since each of the first outermost adhesive layer and the second adhesive layer is merely recited as electromagnetic radiation-curable; and newly amended Fig. 5 also expressly shows that the two layers are of the same material 1B, in the absence of any distinction between the radiation-curable components of the first and second adhesive layers, they do not have distinct properties. While the independent claims recite "different" layers, they do not preclude a single layer from achieving all of them, i.e., the properties of one layer are not exclusive of the other.

With respect to Applicants' argument "to include radiation-curable components into any adhesive layer formed in the tape disclosed by Weng et al. would render the invention inoperable. Specifically, applying radiation would *cure* the adhesive layer, which would prevent a pattern being formed through the tape. Therefore, no mark could be formed through the tape by an ablative photodecomposition process if the adhesive layer of the tape were to include radiation-curable components" (Remarks, page 10, second paragraph), the Examiner notes that Applicants fail to provide any factual support for above-mentioned argument, and it is well settled that Attorney's argument cannot take place of evidence.

Finally, with respect to Applicants' argument "Weng et al. reference merely describes a photodecomposition process employing an excimer type laser for ablating the polymeric based tape. The Weng et al. reference contains no description whatsoever as to how an excimer laser affects the adhesive used with the tape" (Remarks, page 10, 3rd paragraph), the Examiner notes that Applicants are clearly arguing the prior art reference Weng individually. In response to Applicant's arguments,

it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. In particular, the Examiner notes that Weng does expressly teaches that any suitable tape of polymeric based material, which can be easily patterned by high-intensity energy beams such as ultraviolet light or laser, can be used (column 4, lines 27-33). The marking tape adheres to a substrate to be marked (column 2, line 64). As such, since Weng and Robertson are from the same field of endeavor, i.e., forming identification by laser marking, and their combined teaching render the instant invention obvious, Applicants' argument to the contrary notwithstanding.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Victor S Chang
Examiner
Art Unit 1771

7/26/2005


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700